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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,259	03/07/2002	Chad Roberts	P1139.0011/P011	9265

24998 7590 11/16/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
2164	

DATE MAILED: 11/16/2006

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/092,259
Filing Date: March 07, 2002
Appellant(s): ROBERTS ET AL.

Chris Tanner
Of
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 30, 2005 appealing from the Office action mailed May 31, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0090934	Mitchelmore	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchelmore (U.S. publication 2002/0090934).

Mitchelmore discloses:

As to claim 1, Mitchelmore teaches a mechanism for configuring handheld devices (see paragraph 100), comprising:

a website engine, for receiving user input (see paragraph 85);

a build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts (see paragraphs 8, 14, 17-19, 58, 65, 100, 102-103, 178, 181, and 183);

a database engine, for managing executable code and data responsive to the configuration engine (see paragraphs 66, 103, and 150), and

a loading station; for performing the actual downloads (see paragraphs 5 and 103);

wherein the loading station loads the handheld device based on user input received through the website engine and conveyed to the database and build-to-order configuration engines (see paragraphs 8, 18, 65, and 85).

As to claim 2, Mitchelmore teaches wherein the configuration engine communicates automatically with the developers using a registration module (see paragraphs 27, 86, and 90).

As to claim 3, Mitchelmore teaches wherein the registration module communicates with the developers using either pooled, generated, or dynamically requested communications (see paragraphs 19, 66, and 161).

As to claim 4, Mitchelmore teaches wherein the registration module supports the random-key method of software registration (see figure 8 and paragraph 111).

As to claim 5, Mitchelmore teaches wherein the registration module supports the device-ID method of software registration (see paragraphs 96 and 199, table 2).

As to claim 6, Mitchelmore teaches wherein the loading station further comprises a transfer component, which transfers data back and forth over a physical medium through a port,

and an operating system driver layer, which handles the actual moving of the bits through the port over the physical medium (see figure 24 and paragraphs 30 and 131).

As to claim 7, Mitchelmore teaches wherein the transfer component is abstracted such that it sees differing connection types as the same, because the operating system driver layer is responsible for the actual moving of the bits (see paragraph 173).

As to claim 8, Mitchelmore teaches wherein software drivers of the connection types can be added to or removed from the loading station (see paragraphs 92, 106, and 108).

As to claim 9, Mitchelmore teaches wherein software drivers of the connection types are extended from sample software modules obtained from product developers (see paragraphs 18 and 157).

As to claim 10, Mitchelmore teaches wherein the build-to-order configuration engine contains links of which handheld applications cannot coexist with each other or are incompatible with specific handheld hardware (see paragraphs 59, 171, and 184).

As to claim 11, Mitchelmore teaches wherein the build-to-order configuration engine receives data from the handheld device itself through the communication port of the loading station (see paragraphs 8, 18, 65, and 85).

As to claim 12, Mitchelmore teaches wherein the build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, and any other products/applications that it conflicts with (see paragraphs 15-17, 125, 126, and 131).

As to claim 13, Mitchelmore teaches wherein the build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, and any other products/applications that it conflicts with (see paragraphs 15-17, 125, 126, and 131).

As to claim 14, Mitchelmore teaches wherein the database engine comprises a database catalog which contains handheld software pricing and supplier information, lead time, descriptions, sales volume levels, product shots (images), and geographic sales restrictions, all of which is obtained from the developers of the software (see figure 20 and paragraph 52).

As to claim 15, Mitchelmore teaches wherein the database engine further comprises a dependency checker- portion for comparing parameters related to each piece of software (see paragraphs 124 and 125).

As to claim 16, Mitchelmore teaches wherein the build-to-order configuration engine further comprises a plurality of registration code mechanisms each supported by a specialized registration module (see paragraphs 19, 27, 66, 86, 90, and 161).

As to claim 17, Mitchelmore teaches wherein the build-to-order configuration engine further comprises a plurality of registration code mechanisms which can complete the registration process even when all software is preloaded on the handheld device (see figures 29 and 30).

As to claim 18, Mitchelmore teaches wherein a customer sends an existing handheld device to a location having a build=to-order configuration engine, a database engine, and a loading station, wherein the customer accomplishes all download registrations without using the website engine (see paragraph 109).

As to claim 19, Mitchelmore teaches a method of loading software onto a handheld device (see paragraph 3), comprising:

querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate the software (see paragraphs 18-19, 100, 178, 181, and 183), that the desired software has no conflicts with any other software desired by the user, and that the handheld device O/S (Operating System) can accommodate the software (see paragraph 5);

querying the handheld device to ensure sufficient memory is available, and reporting an error back to the user if necessary (see paragraphs 100 and 182);

if necessary, prompting a user to order additional memory such as on a memory card; and locating the software program on the memory card where possible (it will by obvious to have a memory card to load software if the memory of the handheld is full).

(10) Response to Argument

Firstly, Appellant argues that Mitchelmore fail to disclose or suggest a build-to-order configuration.

In response, Examiner maintains that Mitchelmore teaches a build-to-order because the claim limitation "build-to-order configuration engine for..." is optionally because is an intended use and recited accordingly it does not hold any patentable weight.

Secondly, Appellant argues that Mitchelmore fail to disclose or suggest a build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.

In response, Examiner maintains that Mitchelmore teaches "In accordance with at least one embodiment of the invention, the content delivery and management system and method allow end users to select information from any Internet source that is relevant to their personalized needs", (see paragraph 17; where he teaches a build-to-order by a user and where the developer is the user).

"At least one embodiment of the invention provides improved utility in that it allows originators of content and applications, e.g., data content providers, software developers, enterprises, customer service, etc. to implement content delivery and management in a more effective and efficient manner that reduces disruption of their ongoing business", (see Mitchelmore, paragraph 18; where he teaches developers).

"Use of the system and methods according to at least the first embodiment of the invention may require a main installation package and a device-specific installation package. The main installation package may incorporate both the desktop and device components. This package may need to be available for executing directly from the Internet in addition to a standalone, downloadable package. The main installation package may be implemented using or compatible with various technologies, e.g., InstallShield or other products used by software developers to package software so that users can install and uninstall it easily and safely. The device-specific installation package may include only device-specific components. This device-specific installation may be invoked from a desktop computer or from the handheld device. The normal process of subscription through exciting icons in web pages is possible but not desired on a handheld device; therefore pre-installed system-specific services may be required as part of "handheld device only" installations",(see paragraph 183; where he teaches software downloads, developers, and preventing conflicts).

"AnyDevice.TM. and EveryPath.TM. offer hosted software and services as licensed development platforms for creating new mobile applications and extending existing ones to encompass wireless devices", (see paragraph 8; where he teach software licensing)

In accordance with at least one embodiment of the invention, content delivery and management systems may provide outsourced solutions to end users and content providers--where software, solutions, data-management, hosting, bandwidth, support and related services are contracted for through an administrator associated with the content delivery and management system. (see paragraph 58; where he teaches preventing conflicts).

The definition of license is to give permission, to permit, authorize or consent to. In view of this definition Mitchelmore teaches licensing because "When the end user chooses the one-time registration option they are led through a series of pages, one of which prompts them to enter personal details, e.g., name, e-mail, etc., and some indication of acceptance of terms and conditions of system use (see paragraph 102).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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October 10, 2006

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